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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/729,118	12/04/2000	James Norman Cawse	RD-27,953	6825

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EXAMINER
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EPPERSON, JON D

ART UNIT	PAPER NUMBER
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1639

DATE MAILED: 08/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/729,118

Applicant(s)

CAWSE, JAMES NORMAN

Examiner

Jon D Epperson

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1639

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 April 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: Please see attached sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-7, 10, 16 and 37-40.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

### Advisory Action

1. Applicants request to withdraw finality under 706.07(d) has been fully considered (e.g., see 4/15/2004 Response, which is incorporated in its entirety herein by reference) and is hereby denied. The Examiner notes the following in MPEP § 706.07(a), which is reproduced in part below:

Under present practice, second or any subsequent actions on the merits shall be final, except where [1] the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor [2] based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) ... Furthermore, [3] a second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17 (p), of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art. [4] Where information is submitted in a reply to a requirement under 37 CFR 1.105, the examiner may NOT make the next Office action relying on that art final unless all instances of the application of such art are necessitated by amendment. [5] A second or any subsequent action on the merits in any application or patent involved in reexamination proceedings should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed. ... [6] A second or any subsequent action on the merits in any application or patent involved in reexamination proceedings may not be made final if it contains a new ground of rejection necessitated by the amendments to 35 U.S.C. 102(e) by the Intellectual Property and High Technology Technical Amendments Act of 2002 (Pub. L. 107-273, 116 Stat. 1758 (2002)), unless the new ground of rejection was necessitated by an amendment to the claims or as a result of information submitted in an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). ... The claims may be finally rejected if, in the opinion of the examiner, they are clearly open to rejection on grounds of record. Form paragraph 7.40 should be used where an action is made final including new grounds of rejection necessitated by applicant's amendment

Here, Applicants have not set forth any reason that would necessitate withdrawal of the final office action in accordance with MPEP § 706.07(a). For example, Applicants are not claiming that [1] the examiner has introduced a new ground of rejection that is neither

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necessitated by applicant's amendments of the claims or [2] based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) ... etc (e.g., see MPEP § 706.07(a) excerpt above). Applicants' arguments represent a mere traversal of the Examiner's rejections and, as a result, do not constitute a proper basis for withdrawing the finality of the office action (e.g., see 4/15/2004 Response, pages 8-10). In addition, even if assuming arguendo that Applicants' arguments did constitute a proper basis, these arguments would be held non-persuasive for the reasons outlined below.

2. Applicants' further request for reconsideration under 37 C.F.R. § 1.116 (e.g., see 4/15/2004 Response, pages 1-7) is hereby denied because Applicants' arguments were found to be non-persuasive and thus would not place the application in condition for allowance (e.g., see below).

***35 U.S.C. § 103(a) rejection - Maintained***

3. Applicant's arguments directed to the 35 U.S.C. § 103(a) rejection (e.g., see 3/20/04 Response) were fully considered (and are incorporated in their entirety herein by reference) but were not deemed persuasive for the following reasons.

[1] Applicants argue that the references do not represent analogous art and cite *In re Clay* in support of this position (e.g., see 4/15/2004 Response, page 2, paragraph 3).

[2] Applicants argue that Eigen et al., Bottenbruch et al. and Bayer have not been properly combined using the standards set forth in *In re Lee* and further contend that the

Examiner did “not point to support” for the motivation in the rejection and to this end they have requested that the Examiner “state where the motivation to combine teachings appears in the references” (e.g., see 4/15/2004 Response, pages 2-4).

[3] The 35 USC 103(a) rejection is based on only a “selective picking and choosing of the features” in the secondary references, without any basis for doing so (e.g., see 4/15/2004 Response, page 4).

[4] Applicants argue that the Examiner has used impermissible hindsight and cites *In re Deuel* in support of this argument.

[5] Applicants argue that the 35 U.S.C. § 103(a) rejection does not teach all the limitations in the claims (e.g., see 4/15/2004 Response, pages 4-7). With regard to the functional language Applicants argue that their invention is not drawn to an “apparatus” and, as a result, the recited language is not “functional”, but a descriptive physical property (e.g., see page 5, paragraph 2). Applicants also request to state on record where the “diaryl carbonated selective permeation” claim limitation appears in the references.

[6] Applicants argue, “A teaching of a same polymer class (polycarbonate) and a same thickness is not a teaching of a film with the specific selective permeability property recited in the claims” (e.g., see page 4/15/2004 Response, page 6, paragraph 1).

[7] Applicants argue that Eigen et al. does not disclose “two opposing walls comprising permeable polycarbonate film” (e.g., see 4/15/2004 Response, page 6, paragraph 3).

[8] Applicants argue that the “opposing walls are not permeable” (e.g., see 4/15/2004 Response, page 6, paragraph 3).

This is not found persuasive for the following reasons:

[1] The Examiner contends that the cited references do represent analogous art because all three references disclose the use of a polycarbonate film (e.g., see Paper No. 20040320, page 7, last paragraph where this issue was explicitly addressed).

[2] The Examiner contends that there are three possible sources for motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-1458 (Fed. Cir. 1988). In addition to the “prior art” motivation cited by Applicants, the Examiner contends that the “knowledge of persons of ordinary skill in the art” would also provide adequate motivation here because as previously stated “Bottenbruch et al. and Bayer show that these films [required by Eigen et al.] are commercially available and would impart immediate cost and convenience advantages” (e.g., see Paper No. 20040320, page 8, lines 1-2).

In addition, the Examiner has also provided a “prior art” motivation in accordance with *In re Lee* (e.g., see Paper No. 20040320, page 8, first full paragraph, “one of ordinary skill in the art would have been motivated ... because of the favorable chemical and/or physical properties of the film when added as a covering on the plastic plates increase the value and/or use of the plastic plates (e.g., tailor made thickness, favorable gas permeability, ease of manufacture, high heat distortion point, ... favorable thermal stability) (see Bottenbruch et al., column 1, see also Bayer entire document, especially Mechanical Properties, Thermal properties, chemical resistance, etc.), which would prevent contamination and/or degradation of materials placed inside the plastic plates even under unfavorable conditions like high temperatures. For example, the plates of Eigen et al. are designed to rapidly undergo changes in temperature (e.g., see Eigen et al. column 2, especially lines 60-68)”). Thus, the Examiner has provided more than adequate

motivation and explicitly referenced where in the references said motivation could be found.

[3] The Examiner contends that the basis for the 35 USC 103(a) rejection was explicitly stated (e.g., see original rejection, see also above paragraph) and thus Applicants' picking and choosing argument without any basis in the reference for doing so is without merit.

[4] In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

[5] The Examiner argues that all of the claimed limitations have been rendered obvious by the cited references as outlined in the original 35 U.S.C. § 103(a) rejection. In addition, the Examiner notes that it does not matter whether an "apparatus", "product" or "composition" is claimed and, in addition, it does not matter whether Applicants are claiming "functional language" or as a "descriptive physical property" because according to MPEP § 2112.02, "when the structure recited in the reference is substantially identical to that of the claims, *claimed properties [i.e., a descriptive physical property] OR functions [i.e., functional language]* are presumed to be inherent" (emphasis added). Finally, the Examiner notes that the 35 U.S.C. 103(a) rejection has already made it quite clear that the "diaryl carbonated selective permeation" is an inherent property of the film which is disclosed in the rejection (e.g., see 20040320 Response, page 6, paragraph 1 wherein this issue was explicitly addressed at length and *In re*

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*Spada*, *In re Best* and *Ex parte Grey* were cited in support of this position) or, in the alternative, does NOT need to be addressed because it is provided no patentable weight (i.e., the reference does NOT need to provide any reference for this limitation). Thus, the issue is clear with regard to MPEP § 707.07(f).

[6] The Examiner contends that arguments of counsel alone cannot take the place of evidence in the record once an examiner has advanced a reasonable basis for questioning the disclosure. See *In re Budnick*, 537 F.2d at 538, 190 USPQ at 424; *In re Schulze*, 346 F.2d 600, 145 USPQ 716 (CCPA 1965); and *In re Cole*, 326 F.2d 769, 140 USPQ 230 (CCPA 1964). For example, in a case where the record consisted substantially of arguments and opinions of applicant's attorney, the court indicated that factual affidavits could have provided important evidence on the issue of enablement. See *In re Knowlton*, 500 F.2d at 572, 183 USPQ at 37, and *In re Wiseman*, 596 F.2d 1019, 201 USPQ 658 (CCPA 1979). Here, the cited references clearly show that these polycarbonate films are permeable especially to oxygen and carbon dioxide and that this "permeability is inversely proportional to the thickness of the film" (see Bottenbruch et al., column 1, paragraphs 4-5; see also column 4, paragraph 4) (see also Bayer, page 2, column 2 showing various thickness for the polycarbonate film).

[7] In response to applicant's arguments against the Eigen et al. reference individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

[8] In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that the



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opposing walls are permeable) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Accordingly, the 35 U.S.C. § 103(a) rejection cited above is hereby maintained.

***35 U.S.C. 112, first paragraph – Maintained***

4. Applicant's arguments directed to the 35 U.S.C. 112, first paragraph rejection (e.g., see 3/20/04 Response) were fully considered (and are incorporated in their entirety herein by reference) but were not deemed persuasive for the following reasons.

Applicants argue that support can be found at page 4, lines 5-14 and specifically recite a passage therein (e.g., see 4/15/04 Response, page 7)

This is not found persuasive for the following reasons:

The Examiner contends that the passages recited by Applicants are incorrect. Page 4, lines 5-14 in the specification refer to figures 3-5. Furthermore, the caption for figure 2 on page 3 does not state that "each cell can be covered with a different film" (e.g., see specification, pages 3-4).

***35 U.S.C. § 102 - Maintained***

5. Applicant's arguments directed to the 35 U.S.C. § 102 rejection (e.g., see 3/20/04 Response) were fully considered (and are incorporated in their entirety herein by reference) but were not deemed persuasive for the following reasons.

Applicants argue that Hirahara et al. do not teach all the limitations in the claims and specifically ask the PTO to identify elements (1) through (9) and also point out that 26a is drawn to a slotted stamper and not an array of reaction cells (e.g., see 4/15/04 Response, page 8, paragraph 2).

This is not found persuasive for the following reasons:

The Examiner contends that limitations (1) through (9) have been explicitly addressed in the rejection (e.g., see Paper No. 20040320, page 15, last paragraph wherein the diffusion coefficients are addressed i.e., the diffusion coefficients are inherently shown at column 4, line 18). Furthermore, element 26a, as explained in the 103(a) rejection, represents a plate with an array of cells (e.g., see Paper No. 20040320, page 14, paragraph 1), which anticipates the limitation because it meets all of the structural requirements.

Accordingly, the 35 U.S.C. § 102 rejection cited above is hereby maintained.

### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon D Epperson whose telephone number is (571) 272-0808. The examiner can normally be reached Monday-Friday from 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on (571) 272-0811. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Jon D. Epperson, Ph.D.  
August 14, 2003

BENNETT DELSA  
PHARMACEUTICALS

A handwritten signature in black ink, appearing to read "Jon D. Epperson", written over the printed name.